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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,041	05/29/2001	Norihiko Ono	0694-145	7807
7590 01/08/2004				
BRADLEY N. RUBEN, PC 463 FIRST ST. SUITE 5A HOBOKEN, NJ 07030-1859				
			EXAMINER KOPPIKAR, VIVEK D	
			ART UNIT 1775	PAPER NUMBER
DATE MAILED: 01/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,041

Applicant(s)

ONO, NORIHIKO

Examiner

Vivek D Koppikar

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

FINAL OFFICE ACTION

Claim Objections

1. Claim 9 is objected to because of the following informalities: the term "obyd" should be "body". Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-2, 4-10, 12-13 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by US Patent Number 5,827,445 to Yoshida.

Yoshida is directed towards a composite magnetic article for electromagnetic interference suppression.

With regard to Claims 1, 5 and 11-12, Yoshida teaches a method of preparing a soft magnetic powder and then subjecting the soft magnetic powder to annealing so that it is free from stress strain. After the annealing step the powder is mixed with a liquid of the binding agent and the solvent and shaped into an article (film) (Col. 2, Ln. 55-60 and Col. 3, Ln. 25-54).

With regard to Claims 2 and 13, the magnetic powder is treated with a coupling (binding agent) (Col. 3, Ln. 26-36).

With regard to Claims 4 and 15, in one embodiment of Yoshida the binding agent is a polyvinyl chloride agent (Col. 5, Ln. 12-18).

With regard to Claims 6-8, in Yoshida the magnetic sheet is pressed using a roll mill process (Col. 4, Ln. 3-9).

With regard to Claims 9-10 and 16, the composite magnetic material in Yoshida is formed layer by layering and pressing a plurality of sheet elements to form an integral structure. Conductive (dielectric) layers are interposed between sheet elements (Col. 4, Ln. 3-9 and 59-67).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,827,445 to Yoshida as applied to Claims 1-2 above and in further view of US Patent Number 4,696,725 to Ochiai.

Yoshida does not teach using a silane-based coupling agent nor a titanate-based coupling agent.

Ochiai is directed towards a magnetic core body and methods of preparing a magnetic core body.

In Ochiai the magnetic powder is subjected to treatment with a coupling agent which can be chosen from either a titanium or silane based coupling agent (Col. 4, Ln. 14-48). These particular agents are used for their lipophilic properties (Col. 4, Ln. 22-26). At the time of the invention one of ordinary skill in the art would have motivated to use either silane-based coupling agents or titanate-based coupling agents in the process of Yoshida with the expectation

of improving the lipophilic (resistance to forming lipids) properties of the process as recited in Ochiai.

Response to Arguments

6. The claim objections and the 35 USC 112 rejection set forth in the previous office action dated May 28, 2003 have been withdrawn since the amendment filed on October 10, 2003 has satisfactorily overcome these claim objections and the 35 USC 112 claim rejection.

7. Applicant's arguments with respect to claims 1-16, filed on October 10, 2003, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Vivek Koppikar** whose telephone number is **(703) 305-6618**. The examiner can normally be reached on Monday-Friday from 8 AM to 5 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached at (703) 308-3822. The fax phone numbers for the organization where this application or proceeding are assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Vivek Koppikar

12/22/03


DEBORAH JONES
UNIT 1775 EXAMINER